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EXAMINER

HEWITT II, CALVIN L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,506

Applicant(s)

SCHUTZ, JARED P.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-21 have been examined.

Response to Arguments

2. Applicant is of the opinion that the Examiner's appliance of 112 Second paragraph was in appropriate. The Examiner respectfully disagrees. Specifically, Applicant has not provided any evidence that would cause the Examiner to reconsider his analysis of claims 1 and 7-20, therefore, the Examiner maintains the rejection. Regarding the 112 Second Paragraph to claims 19 and 20, data can be encrypted using asymmetric or symmetric algorithms. Data can also be encrypted multiple times, using multiple keys and/or by combining multiple algorithms using various mathematical underpinnings (e.g. primes, elliptic curves, quantum theory). However, Applicant has not clearly defined "private key to private key encryption". Perhaps, it is a typo. The Examiner also maintains the 112 rejections to claims 19 and 20 ("... during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and

unambiguous- *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Regarding claim 3, Applicant asserts that Gabber et al. do not teach "... triggering a communication of real time payment data from a non-customer computer to a vendor computer without customer intervention". It has been held that claims in a pending application should be given their broadest possible interpretation (*In re Pearson*, 181 USPQ 641 (CCPA 1974)). Therefore, as the user does not enter the credit card number of the proxy system in order to trigger a real-time transaction (column/line 12/45-13/14), Gabber et al. teach the communication of real-time payment data without customer intervention. Further, this is in line with Applicant's teaching in which customers provide credit card and order data for initiating a transaction (Specification, page 11, lines 1-26; page 17, lines 13-20; page/line 18/26-19/25). Applicant's arguments directed to claims 1 and 2 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Examiner maintains the rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 7-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 1, recites "implementing the financial transaction by using the encrypted identifier data from the second website". However, the second website doesn't generate, nor perform further processing, using the encrypted identifier, it merely receives it. This step, therefore, is not clear to one of ordinary skill.

Claims 7-18 and 20 are also rejected as they depend from claim 1.

b. Claims 19 and 20 recite "including the step of encrypting some of the data with private key to private key encryption". To one of ordinary skill, it is not clear the cryptographic method that the Applicant is referring to.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7, 15, 16, and 18-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gabber et al., U.S. Patent No. 5,961,593.

As per claims 1-7, 15, 16, and 18-21, Gabber et al. teach a method for using a computer system to implement a financial transaction comprising:

- providing a first web site having identifier data (figure 3)
- encrypting the identifier data (column 8, lines 17-34; column/line 8/63-9/49)
- using a URL to log on to a second website using the encrypted identifier data (abstract; figures 1 and 3-5; column 5, lines 5-33; column/line 5/57-6/61; column 10, lines 10-40)
- implementing the financial transaction (e.g. purchase) using the encrypted identifier from the second website (column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14)

- using a browser to communicate payment data over the internet (figures 3-5; column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14)
- reconciling a payment for the purchase invisibly to the purchaser by using the payment data communicated by the browser to implement the financial transaction (column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14)
- triggering (using a proxy server), over the internet, encrypted real-time payment data from a non-customer computer to a vendor computer without customer intervention (column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14)
- facilitating the transaction using a broker, agent or middleman (column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14)
- executing a card account/bank account to carry out the financial transaction (column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14)
- encrypting the data using a private key (only known by the proxy server) (column 9, lines 10-49)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gabber et al., U.S. Patent No. 5,961,593 in view of Ogram, U.S. Patent No. 5,991,738.

As per claim 7, Gabber et al. teach a method and system for allowing users to securely purchase goods and services over the internet (abstract; figures 1-5; column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14). However, Gabber et al. do not specifically recite the use of attaching data for identifying a transaction to facilitate said transaction. Ogram teaches attaching data identifying a financial transaction to an electronic communication to enable the carrying out of the financial transaction (figures 3D-4B; column 5, lines 1-38). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Gabber et al. and Ogram in order to determine whether the user is authorized to make a purchase ('738, column 5, lines 30-38).

9. Claims 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabber et al., U.S. Patent No. 5,961,593.

As per claims 8-14, Gabber et al. provide a method and system to allow a user to securely purchase goods and services over the internet (abstract; figures 1-5; column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14). Gift

certificates, coupons, rebates and the like are all goods or services, therefore, it would have been obvious to one of ordinary skill to procure, obtain, send and/or redeem certificates, coupons, etc. using the teachings of Gabber, and, further, the mere automation of this process would have been an obvious modification to one of ordinary skill (" ... if a new combination of old elements is to be patentable, the elements must cooperate in such manner as to produce a new, unobvious, and unexpected result. It must amount to an invention."

In re Smith, 161 F.2d 274, 34 C.C.P.A., Patents, 1007; *In re Venner*, 262, F.2d, 91, 95, 120 USPQ 192, 194 (CCPA 1960)).

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gabber et al., U.S. Patent No. 5,961,593 in view of Linehan, U.S. Patent No. 6,327,578.

As per claim 17, Gabber et al. teach a method and system for anonymously obtaining goods and services over the internet (abstract; figures 1-5). Gabber et al. also teach maintaining private user data on a user's computer (column 5, lines 5-28; column/line 5/58-6/17; column 6, lines 36-51). However, Gabber et al. do not specifically recite digital wallets. Linehan teaches a wallet enabled browser for securely maintaining private user data (column 2, lines 17-31; column 14, lines 23-33). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Gabber et al. and Linehan in order to

securely store and communicate transaction data such as credit/debit card data or shipping instructions to allow for more efficient and secure online purchases ('578, column 2, lines 17-31).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3621

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Calvin Loyd Hewitt II

April 21, 2005


JAMES P. TRAMMELL
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